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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/757,332	01/09/2001	Samuel I. Achilefu	MRD-66	5505

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EXAMINER

JONES, DAMERON LEVEST

ART UNIT PAPER NUMBER

1616

DATE MAILED: 04/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/757,332	Applicant(s) ACHILEFU ET AL.	
	Examiner D. L. Jones	Art Unit 1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4-12 and 16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4-12 and 16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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ACKNOWLEDGMENTS

1. The Examiner acknowledges receipt of the amendment filed 1/29/04 wherein claims 1-3, 13-15, and 18-20 were canceled and claims 4 and 16 were amended.

Note: Claims 4-12 and 16 are pending.

RESPONSE TO APPLICANT'S ARGUMENTS/AMENDMENT

2. The Applicant's arguments filed 1/29/04 to the rejection of claims 4-12, 16, and 17 made by the Examiner under 35 USC 112 and/or double patenting have been fully considered and deemed persuasive-in-part for the reasons set forth below.

Statutory Double Patenting

The statutory double patenting rejection over serial number 09/757,333 is WITHDRAWN for reasons of record in Applicant's response.

Obviousness type Double Patenting Rejection

The rejection of claims 4-12 and 16 as being provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 8, 9, 15-17, and 19 of copending application number 09/981,206 is MAINTAINED for reasons of record in the office action mailed 10/29/03.

Note: It is duly noted that Applicant intends to respond to the double patenting rejection when all claims of the instant invention are allowable.

112 Rejection

The 112 rejection is WITHDRAWN because Applicant has amended the claim to overcome the rejection.

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NEW GROUNDS OF REJECTIONS

Double Patenting Rejections

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 4, 5, and 7-12 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 4 and 7-12 of U.S. Patent No. 6,183,726. Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims are directed to a

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method of performing a diagnostic procedure. The claims differ in that the patent claims have specific W5 and X5 values (see patent). However, it would have been obvious to one of ordinary skill in the art that the instant claims are obvious over the patented claims because the instant claims are encompassed in the patented invention when W3 and X 3 are CR1R2; R1 and R2 are (CH₂)_aCO₂H or (CH₂)_aOH and Y3 and Z3 is (CH₂)_aNR₃R₄.

5. Claims 4, 5, and 7-12 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 4 and 7-12 of U.S. Patent No. 6,180,086. Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims are directed to a method of performing a diagnostic procedure. The claims differ in that the patent claims have specific W3 and X3 values (see patent). However, it would have been obvious to one of ordinary skill in the art that the instant claims are obvious over the patented claims because the instant claims are encompassed in the patented invention when W3 and X 3 are CR1R2; R1 and R2 are (CH₂)_aCO₂H or (CH₂)_aOH and Y3 and Z3 is (CH₂)_aNR₃R₄.

112 Second Paragraph Rejections

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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7. Claims 4-12 and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 4-12 and 16: The claims as written are confusing because Applicant has deleted the term 'therapeutic' from the last line of claim 4. However, in claim 4, line 1, the term has not been deleted. Thus, it is unclear if the term was inadvertently missed when Applicant was amending the claims.

COMMENTS/NOTES

8. It should be noted that claims 4-12 and 16 are allowable over the prior art of record for reasons of record in the office action mailed 10/29/03. However, Applicant must address and overcome the double patenting and 112 rejections above.

9. For clarity of the claims, it is respectfully suggested that Applicant insert 'imaging' after 'diagnostic' in claim 4, line 1.

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not


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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. L. Jones whose telephone number is (571) 272-0617. The examiner can normally be reached on Mon.-Fri., 6:45 a.m. - 3:15 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page can be reached on (571) 272-0602. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



D. L. Jones
Primary Examiner
Art Unit 1616

April 12, 2004